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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,195	03/19/2001	Kenji Sekine	T&A-105	8167

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MATTINGLY, STANGER & MALUR, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

CRAVER, CHARLES R

ART UNIT	PAPER NUMBER
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2682

10

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,195

Applicant(s)

SEKINE ET AL.

Examiner

Charles R Craver

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3, 5, 9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Otremba et al, US Pat 4,922,211.

Claim 1: Otremba discloses an RF oscillator comprising a microwave IC 5 (reads monolithic) and a coupled resonator 8 provided on a conductor plate 4 which is tuned by conductive wall portions 1 and 2 and fine tuning portion wall 10 (col 2 lines 12-51).

Claims 2 and 3: Otremba discloses a dielectric support 9 for the resonator which creates an air gap. **Claim 5:** the wall of Otremba covers an upper portion of the resonator.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otremba.

Claim 4: While disclosing applicant's invention of claim 3 above, Otremba fails to disclose that the support contacts the resonator on two sides. However, such a design is functionally equivalent to the design of Otremba, and as such one of ordinary skill in the art would have found such a modification obvious given they both provide the same function.

Claims 6 and 12-15: while disclosing applicant's invention of claims 1-5, Otremba fails to disclose a chip capacitor, however, the use of capacitors in oscillator circuits were so notoriously well-known in the art at the time of the invention that the examiner takes Official Notice of such a feature, asserting that one of ordinary skill in the art at the time of the invention would have found such an element obvious to provide proper signal conditioning.

Claims 7-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cachier, US Pat 4,054,875 in view of Otremba.

Claims 7 and 11: Cachier discloses a transceiver comprising an RF oscillator with a plate supporting a dielectric cavity resonator and a microwave IC (col 2 lines 15-57), as well as reception sections using the oscillator signal for a mixer (col 3 lines 33-42) and a transmission section (col 3 lines 27-32), inherently using an amplifier.

Cachier fails to disclose that the oscillator apparatus is tuned with a conductive wall or that the IC is electromagnetically coupled to the resonator. Otremba discloses

an RF oscillator comprising a microwave IC (reads monolithic) 5 and a coupled cavity resonator 8 provided on a conductor plate 4 which is tuned by conductive wall portions 1 and 2 and fine tuning portion wall 10 (col 2 lines 12-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use such an oscillator in Cachier, as Otremba discloses that such a design allows the oscillator to be more stable and less prone to atmospheric conditions (col 1 lines 26-31). **Claim 8:** since the tuning of the resonator of Otremba is done by the housing, it is read by the examiner that the resonator itself is set in advance. **Claims 9 and 16:** Otremba states that the wall and other portions are sealed with a material (col 2 line 65-col 3 line 12). **Claims 10, 17-19:** Otremba discloses an MIC (reads monolithic).

Claims 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otremba in view of Cachier.

Claims 20, 22 and 24: Otremba discloses a method of assembling an RF oscillator apparatus comprising providing a microwave IC 5 (reads monolithic) and a coupled resonator 8 on a conductor plate 4 and providing conductive wall portions 1 and 2 and fine tuning portion wall 10 (col 2 lines 12-51), and inherently fixing the resonator and the oscillator to the substrate by adhesion and connecting the devices to the substrate, as well as creating an airtight seal around the devices including the substrate (abstract). Since the tuning of the resonator of Otremba is done by the housing, it is read by the examiner that the resonator itself is set in advance.

Otremba fails to disclose wire bonding or a reception and transmission section.

Cachier discloses the utility of providing an oscillator circuit such as that taught by Otremba (col 2 lines 15-57) with transmission (inherently including amplification) and reception/mixing circuits (col 3 lines 27-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use such devices in Otremba as it would allow the device to utilize the produced field and signal (Cachier col 1 lines 40-44). Further, the transmission and reception circuits would obviously be placed in the sealed cavity taught by Otremba, as such would allow the system to be more stable and less prone to atmospheric conditions (col 1 lines 26-31). Lastly, given that the use of wire-bonding was notoriously well-known in the art at the time of the invention, the examiner takes Official Notice of such a feature, asserting that one of ordinary skill in the art at the time of the invention would have considered such to be one of a number of viable electrical connections which could have been used in the combined invention of Otremba in view of Cachier. **Claim 21:** since Otremba discloses a printed circuit board on the substrate (col 2 lines 18-23), such would include a wire substrate (film) supported by the substrate. **Claims 23 and 25-27:** the use of silver paste would have been obvious to one of ordinary skill in the art as functionally equivalent to the solder or other conductive adhesives.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

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Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-27 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-27 of copending Application No. 09/810,400. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hirai, Linn, Kamada, Morino, KashimaMizumura and Takahashi discuss microwave oscillators.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314 for both formal and informal/draft communications, labeled as such.

Hand delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington VA, sixth floor (receptionist).

Any inquiry concerning this or earlier communications from the examiner should be directed to examiner Charles Craver at (703) 305-3965.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached at (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-4700.

CC

C.Craver

June 22, 2004

CC 6-22-04
CHARLES CRAVER
PATENT EXAMINER